

REMARKS/DISCUSSION OF ISSUES

Claims 1-12 are pending in the application.

Applicant(s) thank(s) the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority document(s).

The Examiner is respectfully requested to state whether the drawings are acceptable.

The claims are amended for non-statutory reasons, to correct grammar, remove figure label numbers, and otherwise place them in standard U.S. patent practice format.

The Office action objects to the abstract of the disclosure. The abstract is replaced, and a minor grammatical error in the specification is corrected. No new matter is added. Accordingly, withdrawal of the objection to the specification is respectfully requested.

The Office action objects to claims 1-12 for various informalities. Claims 1-12 are amended to put them into standard U.S. patent practice as requested by the Examiner. However, applicant sees nothing wrong with the term "walls" in reference to "cavity" (singular). A cavity can have more than one wall. In standard English, it is acceptable and proper to refer to the walls of a (single) room or cavity, even when the room or cavity is cylindrical, so that the "walls" are a continuous curved surface bordering the wall or cavity. Additionally, claim 1 and some of the other claims are not restricted to cylindrically shaped cavities, but may include other shapes including those that have one or more flat wall portions. Accordingly, withdrawal of the objection to claims 1-12 is respectfully requested.

The Office action rejects claim 10 under 35 USC § 112, second paragraph for using "a second portion" in an allegedly unclear manner. Claims 9 and 10 are amended in a manner

consistent with the specification to obviate this rejection, without narrowing of the scope of either claim in any way. No new matter is added. Accordingly, withdrawal of the 35 USC § 112, second paragraph rejection of claim 10 is respectfully requested.

The Office action rejects claims 1, 2, 4, and 5 under 35 USC § 102(b) over U.S. Pat. No. 3,077,535 to Dupree. Applicant respectfully traverses this rejection. Independent claim 1, and therefore also claims 2, 4, and 5 that depend from claim 1, are patentable over Dupree at least because Dupree does not teach or suggest all the features recited in claim 1. For example, Dupree does not teach or suggest an upper side of each cavity coated with a reflecting layer.

Conversely, the recesses R taught by Dupree have instead "an opaque shield or light mask 34 [which] may comprise a thin flanged sheet metal disk." The Office action asserts that this metal layer "is considered to be and readable as a first reflecting layer." However, applicant respectfully submits that there is no legal basis to justify making such a leap of assumption. Dupree does not teach that the flanged sheet metal disc is reflecting. When a function (such as reflectivity) is not taught in a reference, the Examiner is justified in assuming inherency of that function only when the composition of the prior art object is the same as that specified in the claim (MPEP 2112), and that is not the case here. Further, just because a metal plate may be reflective does not justify reading "reflecting layer" on that metal plate to support a rejection under §§ 102-103.

**The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ... "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of**

**ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " -- MPEP 2112 (citations omitted)**

In fact, Dupree actually teaches away from making his "opaque shield or light mask 34 ... thin flanged sheet metal disk" reflective, by teaching that "[t]he metal disc also has the function of a thermal conductor to prevent excessive concentration of the heat from the lamp." (Column 4, lines 8-10.) It is well known that if metal near a lamp is to be used as a thermal conductor it should not be made reflective, because then it would be less able to absorb the light and conduct the resulting heat. A reflective surface will actually increase the heat in a cavity by reflecting the light back into it, as is accomplished by reflective metallic insulators for example.

Accordingly, the "reflecting layer" of claim 1 cannot read on the metal disc of Dupree for the purposes of §§ 102-103. Withdrawal of the rejection of claims 1, 2, 4, and 5 is therefore respectfully requested.

The Office action rejects claim 3 under 35 USC § 103(a) over Dupree in view of U.S. Pat. No. 4,998,804 to Horiuchi. Applicant respectfully traverses this rejection. Claim 3 depends from claim 1, which as explained above is patentable over Dupree. Horiuchi does not make up for the deficiency of Dupree, and therefore the two references cannot be combined under 35 USC § 103(a). Accordingly, withdrawal of the 35 USC § 103(a) rejection of claim 3 is respectfully requested.

The Office action rejects claims 6 and 12 under 35 USC § 103(a) over Dupree. Applicant respectfully traverses this rejection. Claims 6 and 12 are patentable over the cited reference for at least the reasons given above with reference to the 35 USC § 102(b) rejection over Dupree. Additionally,

the Office action is incorrect in stating that the use of colored light emitting diodes and the arrangement of the light sources such that no light sources of the same color lie in adjoining cavities would have been an obvious matter of design choice. Applicant's disclosure discusses the advantage of this feature of claim 6 for improving the homogeneity of the mixed color, for example on page 3, lines 25-29. Accordingly, it cannot be considered a mere design choice, but must be given patentable weight.

Additionally, the concept of "obvious design choice" is only applicable where a prior art reference has all the parts recited in the claim, and a worker in the art could rearrange the parts of the reference device to meet the terms of the claim. As the Examiner notes, Dupree does not have the "parts" of the claim (the colored LEDs) and therefore rearranging them would still not satisfy the terms of the claim. And even if it had the parts, there can be no rejection under 35 USC § 103(a) for "design choice" because the Office action does not point to any motivation in the prior art for arranging the colors in the manner specified by claim 6. The Office action is incorrect in stating that a modification involving "mere change in the arrangement replacement of the light sources" is design choice. When the applicant states that a particular arrangement is advantageous, the ability to rearrange the parts of the reference in that way is neither design choice nor obvious, absent a teaching in the prior art of motivation to do so.


**The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. -- MPEP 2144.05 C**

Accordingly, withdrawal of the 35 USC § 103(a) rejection of claims 6 and 12 is respectfully requested.

Applicant thanks the Examiner for his statement that claims 7-11 contain patentable subject matter.

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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